

wherein the R1 substituent is selected from hydrogen and phenyl.

- II. Claims 1–18, in part drawn to a method for preventive treatment of Parkinson's disease in a subject, comprising administering to the subject a compound of the above formula, wherein R1 is a heterocyclic substituent.
- III. Claims 19–20, in part drawn to a kit for diagnosis and treatment of Parkinson's disease comprising a diagnostic agent and a pharmaceutical formulation comprising a compound of the above formula, wherein the R1 substituent is selected from hydrogen and phenyl.
- IV. Claims 19–20, in part drawn to a kit for diagnosis and treatment of Parkinson's disease comprising a diagnostic agent and a pharmaceutical formulation comprising a compound of the above formula, wherein R1 is a heterocyclic substituent.

Applicant provisionally elects with traverse the invention of Group II, embodied in Claims 1–18, wherein R1 is a heterocyclic substituent.

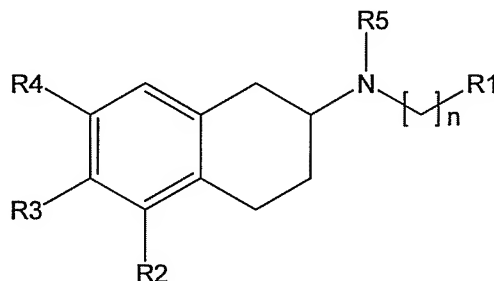
Applicant traverses the present restriction requirement on the grounds that:

- (a) Groups I and II, although patentably distinct, do indeed comply with the unity of invention requirement of PCT Rule 13, at least for the reasons set forth below;
and
- (b) Groups III and IV, although patentably distinct, do indeed comply with the unity of invention requirement of PCT Rule 13, at least for the reasons set forth below.

1.1. Groups I and II

The Action states that the inventions of Groups I and II lack unity of invention because there is allegedly no technical relationship between the groups involving one or more

of the same or corresponding special technical features. In making this assertion, the Examiner defines the core technical feature of these claims as the compound of formula



as defined in Claim 1. Applicant respectfully disagrees with the Examiner's definition of the core technical feature. The claims of Groups I and II (Claims 1–18) share as a common technical feature more than just a compound of the above formula, but a method for preventive treatment of Parkinson's disease comprising administering such a compound to a subject. The Examiner's definition of the core technical feature apparently fails to recognize that the claims of Groups I and II are method-of-use claims for a recognized class of chemical compounds. Thus, any special technical feature analysis under PCT Rule 13.2 should include not only the chemical formula above, but also administration to a subject for preventive treatment of Parkinson's disease.

1.2. Groups III and IV

The present Action restricts the kit claims (Claims 19–20) between Groups III and IV, but does not articulate a reason for this restriction. To the extent that the restriction is based on the same analysis as that provided for restriction between Groups I and II, Applicant submits that the claims of Groups III and IV share as a common special technical feature more than just a compound of the above formula. Groups III and IV share as a special technical feature not only a composition comprising a compound of the above formula, but also a diagnostic agent as defined in Claim 19. Thus, any special technical feature analysis under PCT Rule 13.2 should include not only the chemical formula above, but also the diagnostic agent component of the kit.

1.3. Conclusion

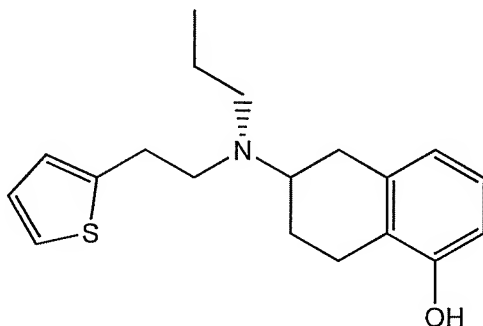
For at least the reasons set forth above, Applicant respectfully requests withdrawal of the present restriction requirements between Groups I and II and between Groups III and IV.

In further support of the above request, Applicant notes that no finding of lack of unity of invention rejection was made in the IPRP dated August 29, 2006 in International Application No. PCT/EP2004/014656, of which the present application represents the national stage under 35 U.S.C. §371. A copy of that IPRP is attached hereto for the Examiner's convenience.

2. Election of species

Applicant is further required to elect a single disclosed species of compound for prosecution on the merits, to which the claims shall be restricted if no generic claim is finally held to be allowable. By election of a species herein, no admission is made or should be inferred that Applicant considers the invention to be limited to that species.

Applicant provisionally elects with traverse the species 5,6,7,8-tetrahydro-6-[propyl[2-(2-thienyl)ethyl]-amino]-1-naphthol, as embodied in Claim 12. The (S)-enantiomer of 5,6,7,8-tetrahydro-6-[propyl[2-(2-thienyl)ethyl]-amino]-1-naphthol is otherwise known as rotigotine and corresponds in structure to:



For clarity, the provisionally elected species corresponds to the formula recited in Claims 1 and 19 wherein

R1 is 2-thienyl;

R2 is OH (OA, wherein A is H);

R3 is H;

R4 is H;

R5 is propyl (C₃ alkyl); and

n is 2.

This species is described throughout the specification, for example at paragraph

Serial No. 10/585,609
6102-000013/US/NP
Response to Action dated June 9, 2008
September 2, 2008

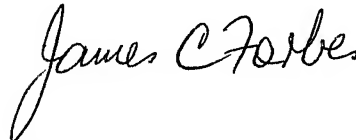
[0035] of the English-language translation of the specification as filed. Each of Claims 1–20 reads on the provisionally elected species.

The present election requirement is traversed on the ground that individual species embraced by Claims 1–20, while patentably distinct, are sufficiently closely related to each other not to impose an undue search burden on the Examiner.

No amendment of inventorship is believed necessary as a result of election herein. Applicant believes the application is now in condition for examination on the merits. Should any issues remain, the Examiner is invited to call the undersigned at the telephone number given below.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

A handwritten signature in cursive script that reads "James C. Forbes".

James C. Forbes
Agent for Applicant
Reg. No. 39, 457
Tel. 847-412-6350

Attachment

IPRP in International Application No. PCT/EP2004/014656 (6 pages)